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SERIAL NUMBER	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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08/139,113 10/21/93 MILNER

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CHOI, K EXAMINER

15N1/0721

DICKSTEIN, SHAPIRO & MORIN
2101 L STREET, N.W.
WASHINGTON, DC 20037

ART UNIT	PAPER NUMBER
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1504

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DATE MAILED: 07/21/95

This is a communication from the examiner in charge of your application.
COMMISSIONER OF PATENTS AND TRADEMARKS

☒ This application has been examined ☒ Responsive to communication filed on 5/8/95 ☒ This action is made final.

A shortened statutory period for response to this action is set to expire 3 month(s), days from the date of this letter.
Failure to respond within the period for response will cause the application to become abandoned. 35 U.S.C. 133

Part I THE FOLLOWING ATTACHMENT(S) ARE PART OF THIS ACTION:

- | | |
|---|---|
| 1. <input type="checkbox"/> Notice of References Cited by Examiner, PTO-892. | 2. <input type="checkbox"/> Notice of Draftsman's Patent Drawing Review, PTO-948. |
| 3. <input type="checkbox"/> Notice of Art Cited by Applicant, PTO-1449. | 4. <input type="checkbox"/> Notice of Informal Patent Application, PTO-152. |
| 5. <input type="checkbox"/> Information on How to Effect Drawing Changes, PTO-1474. | 6. <input type="checkbox"/> _____ |

Part II SUMMARY OF ACTION

1. ☒ Claims 1-21, and 29-39 are pending in the application.

Of the above, claims 1-21 and 29-31 are withdrawn from consideration.

2. ☐ Claims _____ have been cancelled.

3. ☐ Claims _____ are allowed.

4. ☒ Claims 32-39 are rejected.

5. ☐ Claims _____ are objected to.

6. ☐ Claims _____ are subject to restriction or election requirement.

7. ☐ This application has been filed with informal drawings under 37 C.F.R. 1.85 which are acceptable for examination purposes.

8. ☐ Formal drawings are required in response to this Office action.

9. ☐ The corrected or substitute drawings have been received on _____. Under 37 C.F.R. 1.84 these drawings are ☐ acceptable; ☐ not acceptable (see explanation or Notice of Draftsman's Patent Drawing Review, PTO-948).

10. ☐ The proposed additional or substitute sheet(s) of drawings, filed on _____, has (have) been ☐ approved by the examiner; ☐ disapproved by the examiner (see explanation).

11. ☐ The proposed drawing correction, filed _____, has been ☐ approved; ☐ disapproved (see explanation).

12. ☐ Acknowledgement is made of the claim for priority under 35 U.S.C. 119. The certified copy has ☐ been received ☐ not been received ☐ been filed in parent application, serial no. _____; filed on _____.

13. ☐ Since this application appears to be in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under Ex parte Quayle, 1935 C.D. 11; 453 O.G. 213.

14. ☐ Other

EXAMINER'S ACTION

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This Office action is in response to the Amendment filed May 8, 1995. Claims 1-21 and 29-39 are pending in this application.

This application contains claims 1-21 and 29-31 drawn to an invention non-elected with traverse in Paper No. 6. A complete response to the final rejection must include cancellation of non-elected claims or other appropriate action (37 C.F.R. § 1.144) M.P.E.P. § 821.01.

The 35 USC 112 rejections of record are withdrawn in view of Applicants' amendments to the claims.

Claims 32-39 are rejected under 35 U.S.C. § 103 as being unpatentable over Katz (U.S. 4,759,814) in view of Pappas (U.S. 5,071,699).

The rejection is maintained for reasons of record in Paper No. 7.

Further, new claims 33-36 and 38-39 contain various limitations, wherein the layers of the basic invention of claim 32 are rearranged to different positions. It has been held by the Board that shifting of a known part to a different location does not patentably distinguish over the prior art. In re Japikse, 86 USPQ 70, 73. Absent some unexpected result that occurs as a result of the layer rearrangements in the dependent

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claims, such layer rearrangements are considered obvious. This is because all layer rearrangements claimed are functionally equivalent structures.

Applicants' arguments in the Response filed May 8, 1995 have been considered, but they are not deemed to be persuasive for the reasons set forth *infra*.

First, Applicants argue that Katz does not teach resistance to the creation of incendiary discharges and that there would be no motivation to combine Katz and Pappas. The Examiner disagrees. Katz alone may not teach an antistatic agent. However, the desirability of anti-static or anti-incendiary discharges is taught by the Pappas reference. Pappas discloses adding an anti-static agent to reduce static electricity in a bag.

Second, Applicants imply that the suppression of incendiary discharges is an unexpected result. Contrary to Applicant's position, the desirability of anti-incendiary characteristics cannot be said to be unexpected by the skilled artisan at the time of the present invention.

Third, Applicants argue that Pappas fails to disclose the use of cellulose as a charge dissipating agent. Assuming for the moment that this is true, it is elementary that the mere recitation of a newly discovered function or property, inherently

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possessed by things in the prior art, does not cause a claim drawn to those things to distinguish over the prior art. In re Swinehart and Sfiligoj, 169 U.S.P.Q. 226, 229. In re Schoenwald, 22 U.S.P.Q.2d 1671, 1673. The primary reference, Katz, clearly teaches a cellulose layer. Accordingly, whether or not Katz appreciates any inherent anti-static property of cellulose is not relevant.

Fourth, Applicants argue that claims 33-39 include limitations drawn to different positions of different layers. As stated in the rejection above, the shifting of parts of an old invention without increasing its function is prima facie obvious.

Applicant's amendment necessitated the new grounds of rejection. Accordingly, **THIS ACTION IS MADE FINAL**. See M.P.E.P. § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 C.F.R. § 1.136(a).

A SHORTENED STATUTORY PERIOD FOR RESPONSE TO THIS FINAL ACTION IS SET TO EXPIRE THREE MONTHS FROM THE DATE OF THIS ACTION. IN THE EVENT A FIRST RESPONSE IS FILED WITHIN TWO MONTHS OF THE MAILING DATE OF THIS FINAL ACTION AND THE ADVISORY ACTION IS NOT MAILED UNTIL AFTER THE END OF THE THREE-MONTH SHORTENED STATUTORY PERIOD, THEN THE SHORTENED STATUTORY PERIOD WILL EXPIRE ON THE DATE THE ADVISORY ACTION IS MAILED, AND ANY EXTENSION FEE PURSUANT TO 37 C.F.R. § 1.136(a) WILL BE CALCULATED FROM THE MAILING DATE OF THE ADVISORY ACTION. IN NO EVENT WILL THE STATUTORY PERIOD FOR RESPONSE EXPIRE LATER THAN SIX MONTHS FROM THE DATE OF THIS FINAL ACTION.

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Any inquiry to this communication or earlier communications from the examiner should be directed to Kathleen Choi, whose telephone number is (703)308-2432. The examiner can normally be reached on Monday-Thursday from 6:30 a.m. to 5:00 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. George Lesmes, can be reached on (703)308-2362. The fax phone number for this Art Unit is (703)305-5436.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703)308-2351.



GEORGE F. LESMES
SUPERVISORY PATENT EXAMINER
GROUP 150